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In re Application of :
VENKAT et al. :
Application No.: 10/565,662 : DECISION ON REQUEST
PCT No.: PCT/IB04/51281 :
Int. Filing Date: 22 July 2004 :
Priority Date: 25 July 2003 :
Attorney Docket No.: US030231 :
For: FILAMENT CUTOOUT CIRCUIT :

This decision is issued in response to the "Correction of Inventorship under 37 CFR 1.48" filed 06 November 2006, which is being treated as a request under 37 CFR 1.497(d) to correct the inventorship of the present national stage application. Deposit Account No. 14-1270 will be charged the required processing fee.

BACKGROUND

On 22 July 2004, applicants filed international application PCT/IB04/51281 which claimed a priority date of 25 July 2003. The published international application identified two applicant/inventors for the United States: Rama Venkat and Patrick Keegan. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 25 January 2006.

On 23 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; a preliminary amendment; and a copy of the international application.

On 05 May 2006, the United States Designated/Elected Office mailed "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required.

On 06 November 2006, applicants filed the present request under 37 CFR 1.497(d) to add Ernesto Mendoza as an inventor.

DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Ernesto Mendoza to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17; and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

(4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the adding Ernesto Mendoza to the application, applicants' 06 November 2006 submission satisfies requirements (1), (2) and (4).

However, item (3) has not been satisfied. Specifically, the assignee has not established its ownership to the application in accordance with 37 CFR 3.73. Further, it is unclear whether the person executing the "Consent of Assignee" is authorized to act on behalf of the assignee or has apparent authority to sign on behalf of the assignee. Therefore, applicants must provide a copy of the assignment or a specific reference to its recorded location in the United States Patent and Trademark Office (e.g., reel and frame number). (See Manual of Patent Examining Procedure (MPEP) §324 and Statement under 37 CFR 3.73(b).)

Because applicants have not satisfied all the requirements of 37 CFR 1.497(d), inventor Ernesto Mendoza cannot be added to the application on the present record.

CONCLUSION

Applicants' request to add inventor Ernesto Mendoza under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on

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the international application.

Applicants must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a declaration in compliance with 37 CFR 1.497(a)-(b) and a written consent of assignee in compliance with 37 CFR 3.73(b).

Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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